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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/281, 760 03/30/99 LAWTON

R 241/08

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HM12/0605

EXAMINER

EWOLDT, G

ART UNIT	PAPER NUMBER
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1644 //

DATE MAILED: 06/05/00

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary	Application No. 09/281,760	Applicant(s) Lawto et al.
	Examiner Gerald Ewoldt	Group Art Unit 1644

Responsive to communication(s) filed on 8/23/99, 8/27/99.

This action is FINAL.

Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 1 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

Claim(s) 1-115 is/are pending in the application.

Of the above, claim(s) _____ is/are withdrawn from consideration.

Claim(s) _____ is/are allowed.

Claim(s) _____ is/are rejected.

Claim(s) _____ is/are objected to.

Claims 1-115 are subject to restriction or election requirement.

Application Papers

See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

The drawing(s) filed on _____ is/are objected to by the Examiner.

The proposed drawing correction, filed on _____ is approved disapproved.

The specification is objected to by the Examiner.

The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

All Some* None of the CERTIFIED copies of the priority documents have been

received.

received in Application No. (Series Code/Serial Number) _____.

received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____.

Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

Notice of References Cited, PTO-892

Information Disclosure Statement(s), PTO-1449, Paper No(s). _____

Interview Summary, PTO-413

Notice of Draftsperson's Patent Drawing Review, PTO-948

Notice of Informal Patent Application, PTO-152

Fax transmittal form

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

DETAILED ACTION

1. **Please Note:** In an effort to enhance communication with our customers and reduce processing time, Group 1640 is running a Fax Response Pilot for Written Restriction Requirements. A dedicated Fax machine is in place to receive your responses. The Fax number is 703-305-3704. A Fax cover sheet is attached to this Office Action for your convenience. We encourage your participation in this Pilot program. If you have any questions or suggestions please contact Paula Hutzell, Ph.D., Supervisory Patent Examiner at Paula.Hutzell@uspto.gov or 703-308-4310. Thank you in advance for allowing us to enhance our customer service. Please limit the use of this dedicated Fax number to responses to Written Restrictions.

2. Restriction to one of the following inventions is required under 35 U.S.C. § 121:

I. Claims 1-2, 6-11, 15-17, 21-23, 27-30, 34-37, and 41-43 drawn to a specific binding protein which binds a sequence comprising LXXYR, classified in Class 530, subclass 387.9.

II. Claims 3-5, 12-14, 18-20, 24-26, 31-33, 38-40, and 44-46, drawn to a method for treatment of canine allergy using a specific binding protein which binds a sequence comprising LXXYR, classified in Class 424, subclass 139.1.

III. Claims 1-2, 47-50, 54-57, 102-105, and 109-112, drawn to a specific binding protein which binds a sequence comprising CXPHXPXXC, classified in Class 530, subclass 387.9.

IV. Claims 3-5, 51-53, 58-60, 106-108, and 113-115, drawn to a method for treatment of canine allergy using a specific binding protein which binds a sequence comprising CXPHXPXXC, classified in Class 424, subclass 139.1.

V. Claims 1-2, 61-64, 68-71, 75-78, 82-84, 88-91, and 95-98, drawn to a specific binding protein which binds a sequence comprising CXXPHXXXC, classified in Class 530, subclass 387.9.

VI. Claims 3-5, 65-67, 72-74, 79-81, 85-87, 92-94, and 99-101 drawn to a method for the treatment of canine allergy using a specific binding protein which binds a sequence comprising CXXPHXXXC, classified in Class 424, subclass 139.1.

The inventions are distinct, each from the other because:

3. The binding proteins of Inventions I, II, and IV bind different, nonoverlapping, discrete peptide epitopes. Therefore they are patentably distinct.

4. Inventions I/II/V and II/IV/VI are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (M.P.E.P. § 806.05(h)).

In the instant case, the product as claimed can be used in a materially different process such as *in vitro* assays.

5. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter, restriction for examination purposes as indicated is proper.

6. Irrespective of whichever Group Applicant should elect, Applicant is further required under 35 U.S.C. § 121 to:

1)

- A) Elect a **specific** "specific binding protein" binding a **specific** sequence (if Group I, II, or IV is elected)
 - B) Elect a **specific** method of treatment using a **specific** "specific binding protein binding" a **specific** sequence (if Group II, IV, or IV is elected)
- 2) List all Claims readable thereon including those subsequently added. Currently Claims 1, 3, 6, 12, 47, 51, 61, and 65 are generic.

7. Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

The different specific binding proteins and methods of treatment using said proteins are independent and patentable over one another for the following reasons. The different specific binding proteins will have entirely different characteristics depending on the sequences they bind, i.e., whether the bound sequences contain charged or neutral, or hydrophobic or hydrophilic residues. The different methods of treatment will also have different outcomes depending on the specific binding protein used. Therefore, the species of Groups I-VI, are independent and patentable over one another.

8. Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

9. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 C.F.R. § 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a diligently-filed petition under 37 C.F.R. § 1.48(b) and by the fee required under 37 C.F.R. § 1.17(h).

10. Due to the complexity of this restriction and the number of claims involved a telephone restriction was not made.

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dr. Gerald Ewoldt whose telephone number is (703) 308-9805. The examiner can normally be reached Monday through Thursday and alternate Fridays from 7:30 am to 5:30 pm. A message may be left on the examiner's voice mail service. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Christina Chan can be reached on (703) 308-3973. Any inquiry of a general nature or relating to the status of this application should be directed to the Technology Center 1600 receptionist whose telephone number is (703) 308-0196.

Papers related to this application may be submitted to Technology Center 1600 by facsimile transmission. Papers should be faxed to Technology Center 1600 via the PTO Fax Center located in Crystal Mall 1. The faxing of such papers must conform with the notice published in the Official Gazette, 1096 OG 30 (November 15, 1989). The CM1 Fax Center telephone number is (703) 305-3014.

G.R. Ewoldt, Ph.D.
Patent Examiner
Technology Center 1600
May 25, 2000

Christina Chan
CHRISTINA Y. CHAN
SUPERVISORY PATENT EXAMINER
GROUP 1644